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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Paul Lapstun

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 07/06/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,858

Applicant(s)

LAPSTUN ET AL.

Examiner

Saeid Ebrahimi-dehKordy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Defler et al (U.S. patent 5,754,434) in view of Hube (U.S. patent 5,243,381)

Regarding claim 1 and 18, Delfer et al disclose: A printer for printing a collated multi-page document when presented with a plurality of manually collated pages (please note column 8 lines 39-50 and column 9 lines 26-34) However Delfer et al do not disclose: the printer including (a) a code sensor which senses machine-readable codes on the manually collated pages (b) a control unit which uses the machine-readable codes to identify and retrieve previously stored electronic versions of the pages and (c) a print engine which prints the retrieved pages. On the other hand Hube discloses: the printer including (a) a code sensor which senses machine-readable codes on the manually collated pages (please note column 7 lines 65-68 and column 8 lines 1-50) (b) a control unit which uses the machine-readable codes to identify and retrieve previously stored electronic versions of the pages (please note column 3 lines 15-29 where retrieved electronic pages are fetched from the memory) and (c) a print engine which prints the retrieved pages (please note column 3 lines 28-29).

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Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are coded to be fetched at later time for the purpose of being read and printed. This avoids the problem of repeating assembling of multi-page document (see Hube column 3 lines 3-7).

Regarding claim 2 and 19, Hube discloses A printer according to claim 1 further including a binder for binding together the printed pages (please note column 5 lines 18-22).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are coded to be fetched and later on bind together, as this feature make the collating and fetching the document more efficient.

Regarding claim 3 and 20, Hube discloses: A printer according to claim 1 further including a scanner for copying pages which do not have machine-readable codes on them and which produces electronic versions of the pages (please note column 3 lines 15-22).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages

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are electronically coded and stored to be fetched and later on , as this feature make the collating and fetching the document more efficient for the farther use.

Regarding claim 4 ,Hube discloses: A printer according to claim 3 further including a storage medium which stores the electronic versions of the scanned pages (please note column 3 lines 20-30).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use.

Regarding claim 5 Hube discloses: A printer according to claim 1 further including a hand-held code sensor, which senses machine-readable codes on the manually collated pages (please note column 9 lines 64-67 and column 10 lines 1-20) Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use.

Regarding claim 6 ,Hube discloses: A printer according to claim 1 or 5 wherein the machine-readable codes on the manually collated pages are represented:
(a) optically; or (b) electronically; or (c) magnetically; or (d) topographically; or (e) chemically (please note column 3 lines 15-23).

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Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use

Regarding claim 7 and 23 ,Delfer et al disclose: A printer according to claim 1 or 5 wherein the code sensor senses machine readable codes on both sides of the manually collated pages (please note column 6 lines 3-18).

Regarding claim 8 Delfer disclose: A printer according to claim 1 wherein the control unit also controls communications between the printer and one or more peripheral devices (please note Fig.2 as It shows the involving PCs and network, column 6 lines 57-64).

Regarding claim 9 ,Delfer et al disclose: A printer according to claim 1 wherein electronic versions of the manually collated pages which are to be printed are retrieved from at least one of the group including: (a) a storage medium contained within a host computer; (b) a server which is accessed over a computer network; (c) a storage medium contained within the printer itself; or (d) any combination of the above (please note Fig.3 column 6 lines 18-25).

Regarding claim 10 and 24 ,Delfer et al disclose: A printer according to claim 1 further including an input device with which a user of the printer controls the format of the printed and collated multi-page document (please note column 7 lines 62-67 and column 8 lines 1-24).

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Regarding claim 11 ,Delfer et al disclose: A printer according to claim 10 wherein the input device includes a touch sensitive display (please note column 8 lines 10-23).

Regarding claim 12 and 22,Hube discloses: A printer according to claim 1 wherein the print engine also prints machine readable codes onto a page, and wherein the machine-readable codes are not visible to human vision (please note column 3 lines 25-28).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use

Regarding claim 13 ,Delfer et al disclose: A printer according to claim 2 wherein the printer inserts blank pages in the printed document to duplicate blank pages contained within the manually collated pages (please note column 9 lines 26-34).

Regarding claim 14 ,Delfer et al disclose: A printer according to claim 1 wherein instructions from a hand-held code sensor are received and interpreted and a collated multi-page document is produced (please note column 12 lines 42-49).

Regarding claim 15 ,Delfer et al disclose: A printer according to claim 1 further including an interface which transmits instructions for printing a collated multi-page document to a second printer (please note column 7 lines 26-32).

Regarding claim 16 ,Delfer et al discloses: A printer according to claim 15 wherein the instructions are transmitted over a computer network or over a telephone network (please note column 7 lines 61-67).

Regarding claim 17 ,Hube discloses: A printer according to claim 1 further including a storage medium which stores an electronic version of pages which have been printed (please note 9 lines 48-61).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use

Regarding claim 21 ,Hube discloses: A method according to claim 18 wherein the step of printing the retrieved pages includes printing machine-readable codes on those pages (please note column 3 lines 19-29).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use

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Regarding claim 25, Hube discloses: A method according to claim 18 wherein the printing step includes the sub-step of transmitting the retrieved pages to a remote printer (please note column 3 lines 21-29).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Delfer et al's invention according to the teaching of Hube, where Hube is in the same filed of endeavor and teaches the way the electronic pages are electronically coded and stored to be fetched and later on, as this feature make the collating and fetching the document more efficient for the farther use

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

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Or:

(703) 306-5406 (for **informal** or **draft** communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
June 24 2004



SCOTT ROGERS
PRIMARY EXAMINER